

REMARKS

This Reply is in response to the Office Action mailed on December 27, 2005 in which claims 1-18 and 25-40 were rejected. Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

1. Rejection of Claims 1-3, 5-13, 15-18, 25-27, 30-33, 35, and 40 Under 35 U.S.C. § 102(e) as Anticipated by Ganjianpour.

In Section 3 of the Office Action, the Examiner rejected claims 1-3, 5-13, 15-18, 25-27, 30-33, 35, and 40 as anticipated by Ganjianpour, U.S. Patent No. 6,716,250. Applicant respectfully traverses the rejection in view of the following reasons.

Independent claim 1, as amended in Applicant's previous amendment, recites "a shaft coupled to the body" and "a replacement shaft," and further that "the shaft is interchangeable after implantation of the prosthesis by removing the shaft and replacing the shaft with the replacement shaft without dislodging the body from the patient." In Section 3 of the Office Action, the Examiner refers to element 26 of Ganjianpour as the "shaft" and element 30 of Ganjianpour as the "replacement shaft." Applicant agrees with the Examiner that the "shaft 26" and "locking screw 30" of Ganjianpour both meet the plain meaning of the term "shaft" as used in claim 1. However, claim 1 further recites that the shaft is interchangeable without dislodging the body from the patient. The Examiner refers to the "neck element 18" of Ganjianpour as corresponding to the "body" limitation in claim 1. In contrast to the invention of claim 1, the grooved shaft 26 of Ganjianpour may not be removed and replaced without dislodging the neck element 18 from the patient. In fact, it appears that the grooved shaft 26 is integral with the neck element 18. See FIG. 4 (were it not integral, the neck element 18 could not be attached to the stem element 12 with the locking screw 30). Accordingly, while two elements are disclosed in Ganjianpour that meet the plain meaning of "shaft," Ganjianpour does not identically disclose a system that meets every element of independent claim 1, in particular, that the shaft be interchangeable after implantation without dislodging the body from the patient.

Section 5 of the Office Action states that the Applicant contends that "the locking screw of Ganjianpour is not construed as a shaft." Applicant does not make this contention.

Instead, Applicant is relying upon the combination of the various claim limitations of independent claim 1 for patentability as discussed above. Accordingly, independent claim 1 and corresponding dependent claims 2-3, 5-10 and 40 are not anticipated by Ganjianpour under 35 U.S.C. § 102(e).

Similar to claim 1, independent claim 11 recites “wherein the shaft may be removed from the patient after implantation of the prosthesis without also removing the body.” Further, independent claim 25 recites “wherein the second shaft is used to replace the first shaft after implantation of the prosthesis into a patient without first removing the body from the patient.” As discussed above, in both cases, the “shaft 26” of Ganjianpour that is relied upon by the Examiner does not meet this limitation. While the locking screw 30 of Ganjianpour may be removed after implantation without also removing the neck element 18, the Examiner relies upon the locking screw 30 to meet the limitation of the replacement shaft or second shaft, as opposed to the shaft that may be removed without dislodging the body from the patient. Accordingly, independent claims 11 and 25 and corresponding dependent claims 12-13, 15-18, 26-27, 30-33, and 35 are not anticipated by Ganjianpour and are presented for reconsideration and allowance.

2. Rejection of Claims 3-4, 14, 28-29, and 36-39 Under 35 U.S.C. § 103(a)
Based Upon Ganjianpour in View of Pennig.

In Section 4 of the Office Action, the Examiner rejected claims 3-4, 14, 28-29, and 36-39 under 35 U.S.C. § 103(a) as unpatentable over Ganjianpour in view of Pennig, U.S. Patent No. 5,375,956. As discussed above, independent claims 1, 11, and 25 are patentable over Ganjianpour. Pennig does not overcome the deficiencies of Ganjianpour because it does not disclose a body and two shafts, where one shaft may be removed and replaced by the other shaft without removing the body from the patient. Accordingly, dependent claims 3-4, 14, 28-29, and 36-39, which depend from one of claims 1, 11, or 25, are also patentable and are presented for reconsideration and allowance.

3. Claims 19-24.

Independent claim 19 is directed to a method of replacing a shaft of a joint prosthesis having a body, a head, and a shaft after the joint prosthesis has been implanted in a patient. The claim recites "removing the shaft from the patient without removing the body or the head" and "inserting a replacement shaft into the patient." Accordingly, similar to the reasoning with respect to independent claim 1, Applicant respectfully asserts that claim 19 and corresponding dependent claims 20-24 are patentable over either Ganjianpour alone or the combination of Ganjianpour and Pennig. In the Final Office Action, the Examiner did not reject any of claims 19-24. Applicant respectfully requests an indication of allowance of claims 19-24 or a non-final office action citing a basis for rejection of these claims.

4. Conclusion.

Claims 1-40 are pending in the present application. Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 2/27/06

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5897
Facsimile: (414) 297-4900

Jeffrey S. Gunderson
Attorney for Applicant
Registration No. 47,619